

REMARKS

The claims remaining in the present application are Claims 1, 4-10, 12, 15-19 and 22-25. Claims 1, 4-10, 12, 15-19 and 22-25 are rejected. Claims 1 and 19 are amended. No new matter has been added.

35 U.S.C. §102(e) – Claims 1, 4, 5, 19 and 22-25

Claims 1, 4, 5, 19 and 22-25 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,920,112 by McCloghrie et al., hereinafter referred to as the “McCloghrie” reference. Applicants have reviewed the cited reference and respectfully submit that embodiments of the present invention as recited in Claims 1, 4, 5, 19 and 22-25 are not anticipated by McCloghrie for at least the following rationale.

Applicants respectfully direct the Examiner to independent Claim 1 that recites that an embodiment of the present invention is directed to, in part:

A network device comprising:
a processor, wherein said processor is integrated within said network device;
.... (emphasis added).

Independent Claims 19 and 23 recite similar limitations. Claims 4 and 5 that depend from independent Claim 1 and Claims 24 and 25 that depend from independent Claim 23 also include these limitations.

MPEP §2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
... “The identical invention must be shown in as complete detail as

is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

McCloghrie and the claimed invention are very different. Applicants understand McCloghrie to teach a traffic management element that is coupled to a switch. In particular, McCloghrie teaches that the traffic management element is a separate device from the switch, and is coupled to the input and output ports of the switch.

With reference to Figure 1 of McCloghrie, system 100 for collecting information about a packet router or packet switch 110 is shown (col. 3, lines 18-21). Traffic management element 120 is coupled to at least one input interface 111 or output interface 112. Applicants respectfully assert that traffic management element 120 is a separate device from packet switch 110. In particular, in one disclosed embodiment, as shown in Figure 1, traffic management element 120 is a separate device from packet switch 110. Moreover, in another disclosed embodiment, “the traffic management element 120 can be distributed within a plurality of devices, such that sampling of packets 113 occurs at the input interfaces 111 or output interfaces 112, while counting and analysis occur at another logical location” (col. 3, lines 42-46). Furthermore, with reference to Figure 2 of McCloghrie, the adaptive sampling controller 240 of traffic management element 120 receives the packets sampled at packet switch 110.

In contrast, the claimed embodiments recite a network device comprising “a processor, wherein said processor is integrated within said network device”

(emphasis added). Applicants respectfully submit that McCloghie does not teach, describe or suggest the claimed embodiment.

Applicants respectfully note the Examiner's statement that "[a]lthough McCloghie teaches a processor (fig. 1 box 120) that performs sampling, the reference does not explicitly [sic] the processor is integrated within the network device (fig. 1 box 110)" (emphasis added; see Office Action mailed September 25, 2006, page 4, lines 16-19. The Examiner further states that "it would have been obvious to one of ordinary skill in that art, to modify the system of McCloghie by incorporating the sampling functions (fig. 1 box 120) on a single integrated circuit router/switch (fig. 1 box 110). This modification can be performed according to the teachings of Genrich" (emphasis added; see Office Action mailed September 25, 2006, page 5, lines 1-6).

Applicants respectfully submit that the in order to support an anticipation rejection under 35 U.S.C. §102(e), every element set forth in the claims must be found in a single prior art reference. In suggesting that it would be obvious to modify the packet switch of McCloghie to incorporate the traffic management element of McCloghie according to the teachings of Genrich, the Examiner has failed to establish a *prima facie* case of anticipation.

Moreover, Applicants respectfully note the Examiner's statement in the Response to Arguments that the limitation that "said processor is integrated within said network device" is not novel (see Office Action mailed September 25, 2006, page 14, lines 16-21). Applicants maintain that the Examiner has failed to establish a *prima facie* case of anticipation under 35 U.S.C. §102(e).

Therefore, Applicants respectfully assert that nowhere does McCloghrie teach, disclose or suggest the claimed embodiments of the present invention as recited in independent Claims 1, 19 and 23, that these claims overcome the rejection under 35 U.S.C. § 102(e), and are thus in a condition for allowance. Applicants respectfully submit that McCloghrie also does not teach or suggest the additional claimed features of embodiments of the present invention as recited in Claims 4 and 5 that depend from independent Claim 1 and Claims 24 and 25 that depend from independent Claim 23. Therefore, Applicants respectfully submit that Claims 4, 5, 24 and 25 also overcome the rejection under 35 U.S.C. § 102(e), and are in a condition for allowance as being dependent on allowable base claims.

35 U.S.C. §103(a) – Claims 6 and 7

Claims 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over McCloghrie in view of U.S. Patent No. 6,658,006 by Chen et al., hereinafter referred to as the “Chen” reference. Claims 6 and 7 are dependent on independent Claim 1. Applicants have reviewed the cited references and respectfully submit that the embodiments of present invention as recited in Claims 6 and 7 are patentable over McCloghrie in view of Chen for at least the following rationale.

Applicants respectfully assert that the combination of McCloghrie and Chen does not teach, describe or suggest the invention as claimed because the combination of the McCloghrie and Chen does not satisfy the requirements of a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of the claimed invention

(MPEP 2142). Moreover, “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art” (MPEP 2142). In particular, “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)” (MPEP 2143.01). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2131.02; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

McCloghrie and the claimed invention are very different. Applicants understand McCloghrie to teach a traffic management element that is coupled to a switch. In particular, McCloghrie teaches that the traffic management element is a separate device from the switch, and is coupled to the input and output ports of the switch.

With reference to Figure 1 of McCloghrie, system 100 for collecting information about a packet router or packet switch 110 is shown (col. 3, lines 18-21). Traffic management element 120 is coupled to at least one input interface 111 or output interface 112. Applicants respectfully assert that traffic management element 120 is a separate device from packet switch 110. In particular, “the traffic management element 120 can be distributed within a plurality of devices, such that sampling of packets 113 occurs at the input interfaces 111 or output interfaces 112, while counting and analysis occur at

another logical location" (col. 3, lines 42-46). Furthermore, with reference to Figure 2 of McCloghrie, the adaptive sampling controller 240 of traffic management element 120 receives the packets sampled at packet switch 110.

Applicants respectfully note the Examiner's statement in supporting the rejection of Claims 1, 4, 5, 19 and 22-25 under 35 U.S.C. §102(e) that "it would have been obvious to one of ordinary skill in that art, to modify the system of McCloghrie by incorporating the sampling functions (fig. 1 box 120) on a single integrated circuit router/switch (fig. 1 box 110). This modification can be performed according to the teachings of Genrich. This modification would benefit the system by allowing for all functions to be performed on a single, reliable, inexpensive device" (emphasis added; see Office Action mailed September 25, 2006, page 5, lines 1-8).

First, Applicants respectfully submit that McCloghrie does not include any motivation or suggestion to modify a packet switch to include a processor of a traffic management element. In contrast, McCloghrie explicitly states that "the traffic management element 120 can be distributed within a plurality of devices, such that" (col. 3, lines 42-44). In particular, McCloghrie appears to disclose a traffic management element that is a device that can be coupled externally to packet router or packet switch which "are known in the art of computer networks" (col. 3, lines 28-29). Furthermore, by teaching a traffic management element for external coupling to a packet router/switch, Applicants respectfully submit that McCloghrie teaches away from such a modification.

Second, Applicants respectfully submit that Genrich does not overcome the shortcomings of McCloghrie in providing a suggestion or motivation to modify a packet switch to include a processor of a traffic management element.

Applicants understand Genrich to disclose the use of an integrated circuit (col. 3, lines 39-42). In particular, Applicants respectfully submit that Genrich does not teach, describe or suggest “a processor integrated within the network device / integrated circuit capable of performing ... sampling functions” as asserted by the Examiner (see Office Action mailed September 25, 2006, page 4, lines 20-23).

Therefore, Applicants respectfully submit that Genrich does not provide any suggestion or motivation to modify the packet switch of McCloghrie to include a processor of a traffic management element.

Third, Applicants respectfully submit that Chen does not overcome the shortcomings of McCloghrie in providing a suggestion or motivation to modify a packet switch to include a processor of a traffic management element.

Applicants understand Chen to teach a communication device using modified header bits to identify a port (Abstract). Applicants submit that Chen is silent to “a processor, wherein said processor is integrated within said network device”, as claimed. Therefore, Applicants respectfully submit that Chen does not provide any suggestion or motivation to modify the packet switch of McCloghrie to include a processor of a traffic management element.

Fourth, Applicants respectfully submit that the Examiner appears to be relying on impressible hindsight in the assertion that “[T]his modification would benefit the system by allowing for all functions to be performed on a single, reliable, inexpensive device” (see Office Action mailed September 25, 2006,

page 5, lines 6-8). As described above, Applicants respectfully submit that by teaching a traffic management element for external coupling to a packet router/switch, Applicants respectfully submit that McCloghrie teaches away from modifying the packet router/switch to include a processor of the traffic management element, as asserted by the Examiner.

Moreover, neither McCloghrie nor Genrich include a suggestion that benefits are provided "by allowing for all functions to be performed on a single, reliable, inexpensive device", as asserted by the Examiner. Therefore, because McCloghrie does not suggest such a modification, Applicants respectfully submit that it appears that the Examiner is relying on the Applicants' disclosure in providing the suggested modification, and is therefore relying on impermissible hindsight. Therefore, Applicants respectfully assert that there is no motivation to modify the teachings of McCloghrie, as asserted by the Examiner.

In view of the claim limitations not being shown, described or suggested by the combination of McCloghrie and Chen, and the combination of McCloghrie and Chen not satisfying the requirements of a *prima facie* case of obviousness, Applicants respectfully submit that independent Claim 1 overcomes the rejection under 35 U.S.C. § 103(a), and that this claim is thus in a condition for allowance. Therefore, Applicants respectfully submit the combination of McCloghrie and Chen also does not teach or suggest the additional claimed features of embodiments of the present invention as recited in Claims 6 and 7 that depend on allowable base Claim 1. Applicants respectfully submits that Claims 6 and 7 overcome the cited art and are patentable under 35 U.S.C. § 103(a) as these claims are dependent on an allowable base claim.

35 U.S.C. §103(a) – Claims 8 and 9

Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over McCloghrie in view of U.S. Patent No. 6,442,585 by Dean et al., hereinafter referred to as the “Dean” reference. Claims 8 and 9 are dependent on independent Claim 1. Applicants have reviewed the cited references and respectfully submit that the embodiments of present invention as recited in Claims 8 and 9 are patentable over McCloghrie in view of Dean for at least the following rationale.

Applicants respectfully assert that the combination of McCloghrie and Dean does not teach, describe or suggest the invention as claimed because the combination of the McCloghrie and Dean does not satisfy the requirements of a *prima facie* case of obviousness. So as to not unnecessarily duplicate arguments, Applicants respectfully direct the Examiner to the remarks accompanying the discussion of the rejection of Claims 6 and 7 above for a detailed argument as to the lack of suggestion or motivation to modify the teachings of McCloghie in the manner asserted by the Examiner.

Moreover, Applicants respectfully submit that Dean does not overcome the shortcomings of McCloghrie in providing a suggestion or motivation to modify a packet switch to include a processor of a traffic management element. Applicants understand Dean to teach a method for scheduling contexts (Abstract). Applicants submit that Dean is silent to “a processor, wherein said processor is integrated within said network device”, as claimed. Therefore, Applicants respectfully submit that Dean does not provide any suggestion or

motivation to modify the packet switch of McCloghrie to include a processor of a traffic management element.

In view of the claim limitations not being shown, described or suggested by the combination of McCloghrie and Dean, and the combination of McCloghrie and Dean not satisfying the requirements of a *prima facie* case of obviousness, Applicants respectfully submit that independent Claim 1 overcomes the rejection under 35 U.S.C. § 103(a), and that this claim is thus in a condition for allowance. Therefore, Applicants respectfully submit the combination of McCloghrie and Dean also does not teach or suggest the additional claimed features of embodiments of the present invention as recited in Claims 8 and 9 that depend on allowable base Claim 1. Applicants respectfully submits that Claims 8 and 9 overcome the cited art and are patentable under 35 U.S.C. § 103(a) as these claims are dependent on an allowable base claim.

35 U.S.C. §103(a) – Claims 10, 15 and 16

Claims 10, 15 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over McCloghrie in view of U.S. Patent No. 5,596,609 by Genrich et al., hereinafter referred to as the “Genrich” reference. Applicants have reviewed the cited references and respectfully submit that the embodiments of the present invention as recited in Claims 10, 15 and 16 are patentable over McCloghrie in view of Genrich for at least the following rationale.

Applicants respectfully assert that the combination of McCloghrie and Genrich does not teach, describe or suggest the invention as claimed because

the combination of the McCloghrie and Genrich does not satisfy the requirements of a *prima facie* case of obviousness.

First, as described above in discussing the rejection of Claims 6 and 7, Applicants respectfully submit that McCloghrie does not include any motivation or suggestion to modify a packet switch to include a processor of a traffic management element. In contrast, McCloghrie explicitly states that “the traffic management element 120 can be distributed within a plurality of devices, such that” (col. 3, lines 42-44). In particular, McCloghrie appears to disclose a traffic management element that is a device that can be coupled externally to packet router or packet switch which “are known in the art of computer networks” (col. 3, lines 28-29). Furthermore, by teaching a traffic management element for external coupling to a packet router/switch, Applicants respectfully submit that McCloghrie teaches away from such a modification.

Second, as described above in discussing the rejection of Claims 6 and 7, Applicants respectfully submit that Genrich does not overcome the shortcomings of McCloghrie in providing a suggestion or motivation to modify a packet switch to include a processor of a traffic management element. Applicants understand Genrich to disclose the use of an integrated circuit (col. 3, lines 39-42). In particular, Applicants respectfully submit that Genrich does not teach, describe or suggest “a processor integrated within the network device / integrated circuit capable of performing ... sampling functions” (see Office Action mailed September 25, 2006, page 4, lines 20-23). Therefore, Applicants respectfully submit that McCloghrie does not provide any suggestion or motivation to modify

the packet switch of McCloghrie to include a processor of a traffic management element.

Third, as described above in discussing the rejection of Claims 6 and 7, Applicants respectfully submit that the Examiner appears to be relying on impermissible hindsight in the assertion that “[T]his modification would benefit the system by allowing for all functions to be performed on a single, reliable, inexpensive device” (see Office Action mailed September 25, 2006, page 5, lines 6-8). As described above, Applicants respectfully submit that by teaching a traffic management element for external coupling to a packet router/switch, Applicants respectfully submit that McCloghrie teaches away from modifying the packet router/switch to include a processor of the traffic management element, as asserted by the Examiner.

Moreover, neither McCloghrie nor Genrich include a suggestion that benefits are provided “by allowing for all functions to be performed on a single, reliable, inexpensive device”, as asserted by the Examiner. Therefore, because McCloghrie does not suggest such a modification, Applicants respectfully submit that it appears that the Examiner is relying on the Applicants’ disclosure in providing the suggested modification, and is therefore relying on impermissible hindsight. Therefore, Applicants respectfully assert that there is no motivation to modify the teachings of McCloghrie, as asserted by the Examiner.

In view of the claim limitations not being shown, described or suggested by the combination of McCloghrie and Genrich, and the combination of McCloghrie and Genrich not satisfying the requirements of a *prima facie* case of obviousness,

Applicants respectfully submit that independent Claim 10 overcomes the rejection under 35 U.S.C. § 103(a), and that this claim is thus in a condition for allowance. Therefore, Applicants respectfully submit the combination of McCloghrie and Genrich also does not teach or suggest the additional claimed features of embodiments of the present invention as recited in Claims 15 and 16 that depend on allowable base Claim 10. Applicants respectfully submits that Claims 15 and 16 overcome the cited art and are patentable under 35 U.S.C. § 103(a) as these claims are dependent on an allowable base claim.

35 U.S.C. §103(a) – Claim 12

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over McCloghrie in view Genrich, further in view of Dean. Claim 12 is dependent on independent Claim 10. Applicants have reviewed the cited references and respectfully submit that embodiments of the present invention as recited in Claim 12 is patentable over McCloghrie in view of Genrich, further in view of Dean for at least the following rationale.

Applicants respectfully assert that the combination of McCloghrie, Genrich and Dean does not teach, describe or suggest the invention as claimed because the combination of the McCloghrie, Genrich and Dean does not satisfy the requirements of a *prima facie* case of obviousness. So as to not unnecessarily duplicate arguments, Applicants respectfully direct the Examiner to the remarks accompanying the discussion of the rejection of Claims 10, 15 and 16 above for a detailed argument as to the lack of suggestion or motivation to modify the teachings of McCloghie in the manner asserted by the Examiner.

Moreover, Applicants respectfully submit that Dean does not overcome the shortcomings of McCloghrie in providing a suggestion or motivation to modify a packet switch to include a processor of a traffic management element. Applicants understand Dean to teach a method for scheduling contexts (Abstract). Applicants submit that Dean is silent to “a processor, wherein said processor is integrated within said network device”, as claimed. Therefore, Applicants respectfully submit that Dean does not provide any suggestion or motivation to modify the packet switch of McCloghrie to include a processor of a traffic management element.

In view of the claim limitations not being shown, described or suggested by the combination of McCloghrie, Genrich and Dean, and the combination of McCloghrie, Genrich and Dean not satisfying the requirements of a *prima facie* case of obviousness, Applicants respectfully submit that independent Claim 10 overcomes the rejection under 35 U.S.C. § 103(a), and that this claim is thus in a condition for allowance. Therefore, Applicants respectfully submit the combination of McCloghrie, Genrich and Dean also does not teach or suggest the additional claimed features of embodiments of the present invention as recited in Claim 12 that depends on allowable base Claim 10. Applicants respectfully submits that Claim 12 overcomes the cited art and are patentable under 35 U.S.C. § 103(a) as these claims are dependent on an allowable base claim.

35 U.S.C. §103(a) – Claims 17 and 18

Claims 17 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over McCloghrie in view of Genrich, further in view of Chen. Claims 17 and 18 are dependent on independent Claim 10. Applicants have reviewed

the cited references and respectfully submit that embodiments of the present invention as recited in Claims 17 and 18 are patentable over McCloghrie in view of Genrich, further in view of Chen for at least the following rationale.

Applicants respectfully assert that the combination of McCloghrie, Genrich and Chen does not teach, describe or suggest the invention as claimed because the combination of the McCloghrie, Genrich and Chen does not satisfy the requirements of a *prima facie* case of obviousness. Applicants respectfully direct the Examiner to the remarks accompanying the discussion of the rejection of Claims 10, 15 and 16 above for a detailed argument as to the lack of suggestion or motivation to modify the teachings of McCloghrie in the manner asserted by the Examiner.

Moreover, Applicants respectfully submit that Chen does not overcome the shortcomings of McCloghrie in providing a suggestion or motivation to modify a packet switch to include a processor of a traffic management element. Applicants understand Chen to teach a communication device using modified header bits to identify a port (Abstract). Applicants submit that Chen is silent to "a processor, wherein said processor is integrated within said network device", as claimed. Therefore, Applicants respectfully submit that Chen does not provide any suggestion or motivation to modify the packet switch of McCloghrie to include a processor of a traffic management element.

In view of the claim limitations not being shown, described or suggested by the combination of McCloghrie, Genrich and Chen, and the combination of McCloghrie, Genrich and Chen not satisfying the requirements of a *prima facie* case

of obviousness, Applicants respectfully submit that independent Claim 10 overcomes the rejection under 35 U.S.C. § 103(a), and that this claim is thus in a condition for allowance. Therefore, Applicants respectfully submit the combination of McCloghrie, Genrich and Chen also does not teach or suggest the additional claimed features of embodiments of the present invention as recited in Claims 17 and 18 that depend on allowable base Claim 10. Applicants respectfully submits that Claims 17 and 18 overcome the cited art and are patentable under 35 U.S.C. § 103(a) as these claims are dependent on an allowable base claim.

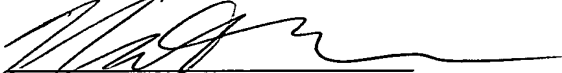
CONCLUSION

In light of the above listed amendments and remarks, reconsideration of the rejected claims is requested. Based on the arguments and amendments presented above, it is respectfully submitted that Claims 1, 4-10, 12, 15-19 and 22-25 overcome the rejections of record. Therefore, allowance of Claims 1, 4-10, 12, 15-19 and 22-25 is respectfully solicited.

Should the Examiner have a question regarding the instant amendment and response, the Applicants invite the Examiner to contact William P. O'Meara at (970) 898-7917.

Dated: 15 Dec, 2006

Respectfully submitted,
WAGNER, MURABITO & HAO LLP



Matthew J. Blecher
Registration No. 46,558

Address: WAGNER, MURABITO & HAO LLP
Two North Market Street
Third Floor
San Jose, California 95113

Telephone: (408) 938-9060 Voice
(408) 938-9069 Facsimile